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3629

PATENT
Attorney Docket No. 10022.0001-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Robert N. MILMAN et al.) Group Art Unit: 3629
Application No.: 09/724,268) Examiner: Naresh Vig
Filed: November 28, 2000)
For: METHOD AND SYSTEM FOR) Confirmation No.: 7895
PROVIDING REAL ESTATE)
INFORMATION USING A COMPUTER)
NETWORK, SUCH AS THE INTERNET)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO REQUIREMENT FOR INFORMATION UNDER 37 C.F.R. § 1.105

On May 16, 2006, the Examiner issued another Requirement for Information under 37 C.F.R. § 1.105, requesting certain additional information from Applicants and declining to examine the pending claims on the merits at this stage of the prosecution. Because this application has been pending since November of 2000 and claims priority to a provisional application filed earlier in 2000 and because no prior art search has been performed and no Office Action has been issued on the merits, Applicants' attorneys sought, and the Examiner graciously granted, a telephone conference to discuss the case. While attempts were made to conduct an interview shortly after the issuance of the Office Action, the Examiner and attorneys were not able to have an interview earlier, because the Office had misplaced a Revocation and New Power of

Attorney and had placed the New Power of Attorney on the PAIR system only shortly before the due date for a response.

On July 13, 2006, the Examiner Vig and Applicants' representatives Leila Abdi and Richard Stroup conducted a telephone interview to discuss the status of the case and the most recent Office Action. During the interview Applicants expressed their position that the case was ready for examination in view of their reply filed on February 21, 2006 and that Applicants deserved a prompt examination of the claims presented in that reply. Applicants respectfully traverse the additional Requirement for Information of May 16, 2006. Nevertheless, to move prosecution forward, both the Examiner and the Applicants discussed the status of the case, the issues raised by the Requirement for Information, and additional issues that should allow the application to be examined on the merits as soon as reasonably possible. It was and is Applicants' understanding that both the Examiner and the Applicants agreed that, with the information provided during the interview or through this response, the application will be ready for examination on the merits.

Applicants wish to thank Examiner Vig for the courtesies extended to Applicants' representatives during the interview. During the interview the Examiner and Applicants discussed the issues raised in the Requirement for Information and additional points raised by either Applicants (a request that any further restriction or election requirement relating to the new claims be handled through a telephone conference) and the Examiner (a request for support of the "affirmative actions" in the newly submitted claims). The interview was completed after both the Examiner and Applicants had addressed any issues or requests that they respectively concluded needed to be

considered to place the case in condition for examination on the merits, after a search of the prior art. Applicants understand that the Examiner has or will prepare an Interview Summary of the interview. During the interview the Examiner explained what he intended to include in the interview summary, and Applicants' representatives also took notes regarding the issues discussed and the agreements reached. At this time, that summary is not available on PAIR.

In the Requirement for Information, the Examiner stated that claims 1-10 were pending for examination and noted that all of the previously claims had been cancelled and that new claims 47-121 were added. The Examiner stated that examination of the new claims will be conducted after the proper claimed priority date has been determined. During the interview, Applicants respectfully submitted that the claims were ready for examination and that the determination of the exact priority of a claim becomes relevant only in response to a rejection, based on the application of specific prior art to specific claims. Applicants are unaware of any law, regulation, or provision of the MPEP that requires that the applicant define the earliest potential priority date for all, or any, claims, until a claim has been rejected based on prior art. All claims obviously have a priority date of at least the filing date of the formal application, namely November 28, 2000. As Applicants have previously represented to the Office, no new matter has been added to the application. If prior art having an effective prior art date of November 28, 2000 is applied to any of the claims, Applicant reserves the right to set forth an earlier priority date based either on the provisional application, which sets forth most if not all of the subject matter of the claims, or on earlier invention dates, though appropriate declarations and other submissions.

With respect to the information requested on page 2, paragraph 3 regarding adding the phrase "no new matter has been added," Applicants explained that they had already made of record, at page 57 of the response filed on February 21, 2006, that no new matter had been added in the amendments. The Examiner accepted Applicants' earlier submission as complying with any requirement.

With respect to the information requested on page 3, paragraph 1 regarding the Rule 131 and 132 affidavits, Applicants during the interview explained that no Rule 131 and 132 declarations were needed or appropriate unless and until there was a rejection in response to which Applicants might file a declaration to either antedate an applied prior art reference or to set forth facts against the rejection. During the interview it was noted that the Office had incorrectly placed on the PAIR system an indication that a declaration had been submitted with the reply of February 21, 2006, and it appeared that the Examiner had sought clarification and additional information because of that error. During the interview, Applicants explained that no Rule 131 or 132 declarations were filed by Applicants on February 21, 2006, as Applicants further confirm through this Response. The Examiner indicated that in view of the above circumstances, no declarations would be required at this stage of the case. For the record, based on Applicants review, it appears that the 131 and 132 declarations that show up on private PAIR are actually a reference to Exhibit A that Applicants submitted with the response on February 21, 2006, and not 131 or 132 declarations as stated on private PAIR under the image file wrapper. Applicants respectfully request that the Office correct that error.

With respect to the information requested on page 2, paragraph 4 regarding the date of Exhibit A, as discussed in the telephonic interview, Applicants explained that the

1988 date as stated on pages 2 and 59 of the reply filed on February 21, 2006 was a typographical error and the correct date should be "1998," as otherwise correctly stated in the remaining portions of the reply. The Examiner accepted Applicants' clarification and correction. Applicants regret this error and appreciate the Examiner's careful review of the reply to ensure that the record is clear.

In the Requirement for Information, the Examiner also requested that Applicants "confirm" that material in Exhibit A was available on January 1, 1988, or else provide a date that which the Examiner must consider as applicant's priority date. Again, Applicants during the interview submitted and by this response submit that setting forth a priority date for any of the claims relative to a specific date earlier than the formal filing date is premature and unnecessary, absent a rejection on the merits. It appears that the Examiner agreed and accepted that position as correct, during the interview. During the interview, Examiner Vig did request Applicants to state the date by which the web pages shown in Exhibit A were available on the Internet. Applicants point Examiner Vig to pages 52-57 of the response filed on February 21, 2006 for the explanation of when and under what circumstances the web pages in Exhibit A were available on the Internet. In that response, Applicants explained how Applicants performed testing as part of the work that led to their invention, the nature of that testing, and the conditions under which third persons could access the test site. Applicants submit that the pending claims are patentable and reserve the right to respond fully regarding priority and patentability over the prior art, in response to any rejections or objections on the merits.

During the interview, Applicants noted that new claims have been presented to better define the full scope of their invention. Applicants explained that these claims had been developed after fully considering the previous restriction requirement made by Examiner and Applicants' responsive election. Nevertheless, Applicants asked that the Examiner call the Applicants representative to the extent that the Examiner felt that any further restriction or election was required, so that prosecution could proceed promptly. The Examiner graciously agreed that he would follow this procedure and explained that he would include the agreement in the Interview Summary. Applicants appreciate the Examiner's willingness to take steps to move prosecution forward.

During the interview, Examiner Vig for the first time asked that Applicants show support for "affirmative action" as recited in claim 47. It is not clear why the Examiner made the request, and no objection or rejection based on that language is part of the record. Nevertheless, Applicants will attempt to address the Examiner's request, to promote prosecution.

During the interview, the Examiner accurately stated that the phrase likely had a different meaning than affirmative action in the Labor Law context. The phrase "affirmative actions" in the claims refers to actions affirmatively (or positively or actively) taken by agents or clients when they are respectively accessing the server of Applicants' invention. The phrase is used in its ordinary meaning, when considered in light of Applicants' disclosure. Affirmative actions generally include inputting information, viewing information or materials, or inputting requests to the server, while on the server, as part of the computer-implemented method of providing real estate information. The disclosure explains that under applicant's invention, agents and clients

(e.g. potential buyers or sellers) access Applicants' server and then affirmative or actively take actions in order to conduct real estate business and offer to sell and purchase homes. For example, affirmative actions by the an agent include positive actions taken by an agent while accessing the server. Affirmative actions by the client or buyer include positive actions taken by the buyer while accessing the server. Some, but by no means all, of the disclosed and claimed affirmative actions are set forth in more detail in dependent claims including claims 52, 54, 55, 56, 69, 88, 89, 90, 99, and 98. Of course, the broadest independent claims are entitled to a full scope of protection encompassed by the ordinary meaning of the phrase, in light of the disclosure.

Applicants believe that they have provided all of the information requested by the Examiner and the case is ready to be examined on the merits. Applicants therefore look forward to the Examiner completing a search of the prior art and providing a complete Office Action setting forth fully the Examiners' review and examination of the claims and an identification of any and all issues that the Examiner concludes are appropriate for consideration, in formal and full objections, rejections, and allowances of the pending claims. Applicants respectfully submit that piecemeal prosecution or further formal Requirements for Information would be inappropriate, given the status of the case and the applicable law.

Should the Examiner believe that he needs anything else before a full examination can be completed and a formal Office Action issued, Applicants respectfully request that the Examiner contact the undersigned by phone, so that any further clarifications can be made promptly, thereby promoting the prompt examination of the case, which is already several years old.

In addition, it is not believed that any additional fees are due but if necessary, please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account no. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: July 17, 2006

By: 
Leila R. Abdi
Reg. No. 52, 399